

Appl. No. : 10/606,982 Confirmation No. 6440
Applicants : Lewis, Michael
Filed : 06/26/2003
TC/A.U. : 3764
Examiner : Demille, Danton
Docket No. : 244.002
Customer No. : 9809
Response of 12/2/2005 to Office Action of September 6, 2005

AMENDMENTS TO THE DRAWINGS

Applicant has amended the drawings to delete references 29-31. Additionally, Applicant has amended Figs. 5A-5D to replace the bracket with an arrow.

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REMARKS

In the Office Action dated 06 September 2005, Examiner objected to the drawings as failing to comply with 37 CFR 1.84(p)(5). Further, Examiner rejected claims 5, 6, 9, 10, 24-27, 30, and 31 as being indefinite for failing to particularly point out and distinctly claim the subject matter. Further, Examiner rejected claims 1-4, 24-27, 30, and 31 as being anticipated by Van Brunt ("the '785 patent"). Further, Examiner rejected claims 6-11 as being obvious over the '785 patent and in view of Arkans. Finally, Examiner rejected claims 1-11, 23-27, 30, and 31 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 6,620,116. For the reasons stated below, applicant asserts that the drawings and claims 1-11, 23-27, 30, and 31 should be allowed.

Examiner kindly granted three interviews with Applicant. In the first interview, dated September 19, 2005, Examiner confirmed that there was no rejection of claim 5. In the second interview, dated September 28, 2005, Examiner and Applicant discussed possible arguments for overcoming the rejections cited in the Office Action. Overall, Examiner and Applicant did not reach an agreement regarding the claims. Examiner rejected Applicant's suggestion that the claims be restricted to the application of pressure on the blood vessels outside the ribcage, as Examiner indicated that this limitation would be considered intended use. Instead, Examiner suggested that the difference in the frequency of oscillations may distinguish the present application over the '785 patent. In the third interview, dated October 26, 2005, Examiner clarified the objection regarding Figs. 5A-5D and reiterated amending the claims to define over the high frequency oscillation function of the '785 patent.

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I. Drawings

A. Applicant has amended the drawings to delete references 29-31 and reference 24 on Figs. 5A-5D; therefore the objection should be withdrawn and the drawings should be allowed.

Examiner objected to the drawings as failing to comply with 37 CFR 1.84(p)(5) for including references 29-31 not mentioned in the description. Applicant has amended the drawings to delete references 29-31. Additionally, Examiner objected to the drawings as failing to comply with 37 CFR 1.84(p)(5) for using a bracket (24) in Figs. 5A-5D, asserting that Figs. 5A-5D are not a true exploded view. Applicant asserts that Fig. 5C is an exploded view of a component of Fig. 5B. Further, Applicant asserts that Fig. 5D is an exploded view of a component of Fig. 5A. However, Applicant has amended Figs. 5A-5D to replace the bracket with an arrow. Therefore, Applicant has traversed Examiner's objections and respectfully submits that the drawings should be allowed.

II. Claim Rejections

A. Claim Rejections – 35 U.S.C. 112

Examiner rejected claims 5, 6, 9, 10, 24-27, 30 and 31 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 5 has been amended to replace "flexible surface layer" with "cuff." Claim 6 has been amended to provide antecedent basis for "said flexible surface layer, flexible bladder, and flexible liner layer." Claim 9 has been amended to delete "section," thereby providing antecedent basis for "flexible liner layer." Claim 10 has been amended to provide antecedent

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basis for "flexible bladder." Claim 1 has been amended to provide basis for "pulsation," found in claims 24-27, 30, and 31. As Applicant has amended the claims to provide clear antecedent basis, claims 5, 6, 9, 10, 24-27, 30, and 31 now particularly point out and distinctly claim the invention, and should be allowed.

B. Claim Rejections – 35 U.S.C. 102

Examiner rejected claims 1-4, 24-27, 30, and 31 under 35 U.S.C. 102(e), as being clearly anticipated by the '785 patent.

1. Independent Claim 1 should be allowed as Claim 1 is patentably distinguishable over the '785 patent.

A rejection under 35 U.S.C. 102(e) can be overcome upon a showing that the present invention is patentably distinguishable over the prior art. MPEP 706.02(b). The '785 patent requires that the chest wall oscillator provide a means for maintaining the oscillation compressive force at a substantially constant level. (the '785 patent, col. 2, lns. 24-29; col. 6, lns. 35-67; col. 7, lns. 1-67, col. 8, lns. 1-67) Applicant amended Claim 1 to include the additional limitations "said electromechanical actuator unit controllably operable from said relaxed position to any of said positions within said range of positions; and said electromechanical actuator unit operable at variable frequency, at least one said frequency responsive to at least one said physiological data." Consequently, Claim 1 provides that the actuators may variably oscillate. Therefore, as the '785 patent requires maintaining the oscillation compressive force at a substantially constant level, and as Claim 1 of the present

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invention provides variable frequency, Claim 1 is patentably distinct over the '785 patent and should be allowed.

2. Dependent claims 2-4, 24-27, 30, and 31 should be allowed as they all depend from allowable Claim 1, thereby rendering claims 2-4, 24-27, 30, and 31 also patentably distinguishable over the '785 patent.

Examiner also rejected Claims 2-4, 24-27, 30, and 31 as being anticipated by the '785 patent. Claims 2-4, 24-27, 30, and 31 are dependent claims, thereby adding further limitations to Claim 1. As previously stated, the rejection of Claim 1 was improper and Claim 1 should be allowed. Because Claim 1 is allowable, dependent Claims 2-4, 24-27, 30, and 31 should also be allowed.

C. Claim Rejections – 35 U.S.C. 103

To establish a *prima facie* case of obviousness, [1] there must be some suggestion or motivation to modify the reference or combine the reference teachings; [2] there must be reasonable expectation of success; and [3] the prior art must teach or suggest all the claim limitations. MPEP 706.02(j). All three requirements must be met for a valid finding of obviousness.

1. Claims 6-9 and 11 depend from allowable Claims 1, thereby rendering Claims 6-9 and 11 allowable.

Examiner rejected claims 6-9, and 11 under 35 U.S.C. 103(a) as being unpatentable over the '785 patent. Claims 6-9 and 11 all depend from allowable Claim 1, thereby only adding further limitations to allowable Claim 1. Therefore, Claims 6-9 and 11 should also be allowed.

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2. Claim 10 depends from allowable Claim 1, thereby rendering Claim 10 allowable.

Examiner rejected claim 10 under 35 U.S.C. 103(a) as being unpatentable over the '785 patent in view of Arkans. Claim 10 depends from allowable Claim 1, thereby only adding further limitations to allowable Claim 1. Therefore, Claim 10 should also be allowed.

D. Double Patenting: Upon indication of allowable subject matter, Applicant is willing to disclaim the terminal part of any patent granted on the instant application, which would extend beyond the expiration date of U.S. Patent No. 6,620,116.

Examiner rejected Claims 1-11, 23-27, 30, and 31 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-37 of U.S. Patent No. 6,620,116 ("the '116 patent"). A rejection based on a nonstatutory type of double patenting can be avoided by filing a terminal disclaimer in the application in which the rejection is made. MPEP 804.02 (II). Upon the indication of allowable subject matter, Applicant is willing to disclaim the terminal part of any patent granted on the instant application, which would extend beyond the expiration date of the '116 patent.

E. Information Disclosure Statement: Applicant acknowledges that the cited Chinese patent document and the Cohen non-patent literature will not be considered by the Examiner.

Applicant indicated in Information Disclosure Statement that Applicant did not have access to the Chinese patents. Applicant acknowledges that such references will not be considered by the Examiner.

APPENDIX A